

#5

Rec'd PCT/PTO 15 APR 2002

Express Mail No.EL 477 035 829 US:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Salamone et al.

Application No.: 09/890,536

Group Art Unit: Not assigned yet

Filed: July 28, 2001

Examiner: Unknown

For: METHOD AND SYSTEM FOR
DYNAMIC CONFIGURATION OF
ACTIVATORS IN A CLIENT-
SERVER ENVIRONMENT

Attorney Docket No.: 9318-022-999

PETITION UNDER 37 C.F.R. § 1.47(a)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

It is respectfully requested that JULIE A. SALAMONE, RONALD C. WITHAM, Jr., PAUL KIELY, and KEVIN SULLIVAN, co-inventors with ALAN CLARKE of the invention disclosed and claimed in the above-identified patent application be permitted to make this application for patent on behalf of themselves and ALAN CLARKE. The reasons for making this petition are set forth below.

09/10/2002 SNAJARO 00000019 161150 09890536

01 FC:122

130.00 CH

I. FACTS

JULIE A. SALAMONE, RONALD C. WITHAM, Jr., PAUL KIELY, KEVIN SULLIVAN, and ALAN CLARKE are the true and first co-inventors of the invention disclosed and claimed in the above-identified patent application, Application Serial No. 09/890,536, filed July 28, 2001 (the "536 Application") with the United States Patent and Trademark Office as the National Phase of the application PCT/US00/02014 filed on January 28, 2000 (the "PCT Application"). The above-identified application is owned, by equitable or legal assignment, by IONA CORPORATION ("IONA"), employer of the five named inventors at the time the invention was made.

The '536 Application is the national phase filing of the Application filed pursuant to the Patent Cooperation Treaty, Application Serial No. PCT/US00/02014 filed on January 28, 2000. The PCT Application, itself, claims priority from a United States Provisional Patent Application Nos. 60/117,943 60/117,948, and 60/117,949 (collectively the "provisional applications"), all filed on January 29, 1999.

The provisional applications do not name ALAN CLARKE as an inventor, and instead name ROBERT KUKURA, JULIE A. SALAMONE, and RONALD C. WITHAM, Jr. as inventors. ALAN CLARKE was named as an inventor for the first time in upon filing the PCT application.

The PCT Application was filed on behalf of IONA and the five named inventors, JULIE A. SALAMONE, RONALD C. WITHAM, Jr., PAUL KIELY, KEVIN SULLIVAN, and ALAN CLARKE, in accordance with IONA's ownership of the inventive matter as the employer of the named inventors.

No declaration was required for the filing of either the PCT application or the provisional applications.

In the duration between filing of the priority applications and the '536 application based on the PCT application, ALAN CLARKE ceased to be employed by IONA and also moved from his last known address.

The last known address for ALAN CLARKE is 4 the Borough, Phibsboro, Dublin 7, Ireland.

On or before November 7, 2001, in response to a request by Applicants' attorneys for executed declarations, Dr. Sean Baker, the Chief Corporate Scientist at IONA Technologies, Inc. instructed Ms. Margaret O'Keefe to locate inventors of the '536 application for filing the required executed declarations required for completing the National Phase US filing for the PCT application.

On or before November 7, 2001, Ms. Margaret O'Keefe determined that three of the named inventors, ALAN CLARKE, PAUL KIELY, and KEVIN SULLIVAN, all Irish Nationals were no longer working for IONA.

Ms. Margaret O'Keefe located KEVIN SULLIVAN in Spain, and received an executed declaration via facsimile.

Similarly, Ms. Margaret O'Keefe located PAUL KIELY, and received an executed declaration via facsimile.

RONALD WITHAM provided his executed declaration via facsimile from Canada, while JULIE SALAMONE executed her declaration in the United States.

Ms. Margaret O'Keefe was unable to locate Mr. ALAN CLARKE based on information available in the records of IONA Technologies.

IONA Technologies does not have, presently, in its possession, a current address for ALAN CLARKE from which a response could be elicited to a request to execute the declaration.

IONA Technologies does not have, presently, in its possession, an address for a common acquaintance or a bank account number, electronic mail address, or telephone number that could be used to locate ALAN CLARKE.

II. ALAN CLARKE IS UNAVAILABLE DESPITE DILIGENT EFFORTS TO LOCATE HIM

IONA Technologies is continuing its diligent efforts for locating Mr. Alan Clarke, and intends to request his cooperation in prosecuting the '536 application and any applications based on it as required.

As detailed above and as evidenced in the affidavit executed by Ms. Margaret O'Keefe submitted herewith, IONA Technologies has made diligent efforts made to timely locate ALAN CLARKE, so that he could execute a Declaration as required. This effort has, however, not been successful. The last address for ALAN CLARKE is as follows:

4 the Borough,
Phibsboro,
Dublin 7, Ireland

However, this address is known to be incorrect since the last correspondence forwarded to this address was returned with the indication that there was no forwarding address.

In view of all of the detailed facts, Attorneys for Applicants submit that ALAN CLARKE cannot be reached, despite diligent effort.

III. CONCLUSION

It is respectfully submitted that ALAN CLARKE cannot be reached despite diligent effort. Attorneys for Applicants are unable to reach him as a matter of fact. Thus, Applicants request that the Petition to make the application on behalf of themselves and for

ALAN CLARKE be granted. Please charge the petition fee required by 37 C.F.R. § 1.17(h) of **\$ 130.00** to Pennie & Edmonds LLP Deposit Account No. 16-1150. A copy of this sheet is enclosed.

Respectfully submitted,


Garland Stephens 37,242
(Reg. No.)

PENNIE & EDMONDS LLP
1155 Avenue of the Americas
New York, New York 10036-2711
(212) 790-9090

Enclosure

AFFIDAVIT

I, Margaret O'Keefe, hereby certify that with respect to US patent application 09/890,536, which is the National phase of PCT/US00/02014 filed on January 28, 2000 and entitled "METHOD AND SYSTEM FOR DYNAMIC CONFIGURATION OF ACTIVATORS IN A CLIENT-SERVER ENVIRONMENT" that:

Over the last five months upon instruction of Sean Baker, the Chief Corporate Scientist of IONA Technologies, I have attempted to locate the inventors of the aforementioned patent application.

The best and last known address I have been able to determine for Mr. Alan Clarke, a previous employee of IONA Technologies Plc, is 4 The Borough, Phibsboro, Dublin 7, Ireland.

IONA retained rights in the work Mr. Clarke performed for IONA as part of Mr. Clarke's normal contractual obligations with IONA. Mr. Clarke was an employee of IONA at the time the invention of the aforementioned patent application was made.

Attempts to contact Mr. Clarke from his last known address and telephone number have been unsuccessful.

The company has no other information that would lead to Mr. Clarke.

Efforts are ongoing to locate him, and upon success, we will seek his cooperation. Efforts are ongoing to locate him, and upon success, we will seek his cooperation.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

BY: Margaret O'Keefe

Margaret O'Keefe
Executive Assistant - SVP Engineering
IONA Technologies

WITNESS BY: Sean Baker

Sean Baker
Chief Corporate Scientist
IONA Technologies